

### **REMARKS**

Claims 1-18 are pending.

Claim 1 is an independent claim.

### **Drawings**

The indication that the drawings filed were accepted is noted.

### **Foreign Priority**

The indication that the foreign priority document was received and placed in the file is noted.

### **Information Disclosure Statement**

The indication that the Information Disclosure Statement filed on July 27, 2001 was considered is noted.

### **Reply to Objections**

The title of the invention was objected to. A new title has been provided.

The Examiner is requested to reconsider and withdraw the objection to the title.

Additionally, a new Abstract has been provided, which is more consistent with U. S. practice. The Examiner is requested to approve the new Abstract.

## **Reply to Rejections**

### **First Rejection**

Claims 3 and 4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner stated, "Regarding claims 3-4, the limitations as cited are unclear and/or confusing. The recovery treatment should only take place when the determination of last printed operation time is "valid" according to the original file specification." This rejection is traversed.

As set forth in the specification, for example, on page 10, the claim is supported. For example, page 10, lines 16-23 reads as follows:

In this configuration, when the completion time of the printing operation read out from the ink-jet printer is invalid hence it is impossible to compute an exact value of the inactive time to be used to determine whether an execution of a recovery treatment is needed or not, a recovery treatment execution order is necessarily issued to the ink-jet printer. Therefore, it is possible to positively prevent ink ejection failures and nozzle clogging.

As can be seen, for example, the features of claims 3 and 4 are supported in the specification.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of claims 3 and 4 under 35 U.S.C. § 112, second paragraph.

### **Second Rejection**

Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hori (U.S. Patent 5,847,726) in view of Mizutani (U.S. Patent 6,078,400). This rejection is traversed.

Even assuming that Hori discloses what is set forth in the rejection, the addition of Mizutani, which is directed to an ink-jet printer shared by a multiple number of host machines, does not cure the innate deficiencies of the rejection based on the first reference.

For example, there is no dispute that ink-jet printers can be shared by a multiple number of host machines. See, for example, the statement of what is conventional in the specification. But the combination that has been claimed is not shown or suggested by the applied references and, accordingly, a rejection under 35 U.S.C. § 103 is not valid and no *prima facie* case of obviousness has been established.

For example, in base claim 1, it is required that “each host machine includes a print control means for reading out the completion time for the ink-jet printer at the start of a printing operation.” That is, it is emphasized in claim 1 that there is a print control means for reading out the completion time for the ink-jet printer in each host machine. Combining both the references applied does not show or suggest this feature. In the context claimed, it is more than just providing multiple print devices that share an ink-jet printer.

It appears that the Examiner has not considered the claimed combination as a whole. This is improper in a rejection under 35 U.S.C. §103. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986), wherein the Court stated as follows:

Focusing on the obviousness of substitutions and differences instead of on the invention as a whole ... was a legally improper way to simplify the difficult determination of obviousness.

Also, the Examiner may be asserting that the invention is obvious because one skilled in the art is capable of doing what has been claimed, but this not a proper basis for a rejection under

35. U.S.C. § 103. See *Ex parte Levingood*, 28 USPQ2d 1300 (BPAI 1993), wherein the Board stated as follows:

At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. (Emphasis added.)

Even if a *prima facie* case of obviousness had been established, which it has not, it appears that the Examiner has not considered the results achieved by the claimed combination. For example, in the specification, page 3, first full paragraph, some of the results of the claimed combination are set forth in the first full paragraph. In determining obviousness, results of the invention must be considered as mandated by the courts. See *Gillette Co. v S.C. Johnson Inc.*, 16 USPQ2d 1923 (Fed. Cir. 1990), which states as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in *Interconnect Planning Corp. v. Feil*, F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985)... [Cited in the MPEP].

With respect to the dependent claims, these claims are considered patentable at least for the same reasons as their base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35. U.S.C. § 103.

**Additional Art Cited**

On page 5 of the Office Action, under the heading “**Conclusion**,” the Examiner cited additional prior art. As this additional prior art was not applied, no comments are considered necessary.

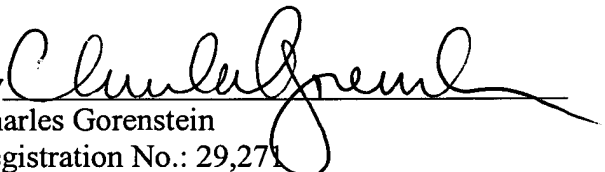
**Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33.347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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